

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Reissue Application of:

Buhr, *et al*

U.S. Patent No.: 5,672,697

Issued: September 30, 1997

Serial No.: 652,978

Group Art Unit: 1623 \*

Filing Date: February 8, 1991

Examiner: G. Kunz \*

For: NUCLEOSIDE 5'-METHYLENE PHOSPHONATES

Assistant Commissioner for Patents  
Washington DC 20231

Sir:

COMBINED REISSUE APPLICATION DECLARATION AND POWER OF  
ATTORNEY BY INVENTOR(S) OR ASSIGNEE<sup>1</sup>

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(Complete A or B)A. ☒ Declaration by Inventor(s):

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name;  
and

I verily believe that I am the original, first and sole inventor (if only one name is listed below), or an original, first and joint inventor (if plural names are listed below) of the subject matter that is claimed in letters patent number 5,672,697 granted on September 30, 1997 and in the foregoing specification and for which invention I solicit a reissue patent;

B. ☐ Declaration by Assignee:

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\* Enter the Group Art Unit and Examiner from which the original patent was issued.<sup>1</sup> This declaration must be accompanied by Consent of Assignee for Reissue and Assignee's Statement of Ownership Interest.09408396-092599  
656260-9680460

Note: The assignee of the entire interest may make the declaration if the reissue application does not seek to enlarge the scope of the claims of the original patent, 37 C.F.R. §1.172.

@@ (Name of declarant), @@ (title), of @@ (Name of company or legal entity on whose behalf declarant is authorized to sign) declare that I am a citizen of @@ and resident of @@, that the entire title to letters patent number @@ for @@, granted on @@ to @@ is vested in @@ (name of company or legal entity), that I believe said named inventor(s) to be an original, first and sole inventor (if only one name is listed) or an original, first and part inventor (if plural names are listed) of the subject matter that is described and claimed in the aforesaid letters patent and in the foregoing specification and for which invention I solicit a reissue patent.

### ACKNOWLEDGMENT OF REVIEW OF PAPERS AND DUTY OF CANDOR

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims.

I acknowledge the duty to disclose all information known to be material to the patentability of this application in accordance with 37 C.F.R. § 1.56.

☐ In compliance with this duty attached herewith is an Information Disclosure Statement in accordance with 37 C.F.R. § 1.97.

### PRIORITY CLAIM

I hereby claim foreign priority benefit under 35 U.S.C. § 119 of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of any application on which priority is claimed.

☐ No such applications have been filed.

☐ Such applications have been filed as follows:

Country	Application No.	Date Filed	Priority Claimed
_____	_____	_____	_____
_____	_____	_____	_____
_____	_____	_____	_____

### STATEMENT OF INOPERATIVENESS OR INVALIDITY OF ORIGINAL PATENT 37 C.F.R. §1.175

That I believe the original patent to be

- ☒ partly  
☐ wholly

inoperative or invalid by reason of

- ☐ a defective ☐ specification, ☐ drawing, ☐ both  
☒ said patent claiming  
☐ more  
☒ less

than patentee had a right to claim.

The scope of the claims of the original patent

- ☒ are enlarged  
☐ are not enlarged

by this reissue application.<sup>2</sup>

In particular, patentees erred in not claiming the chemical compounds set forth in claims 9-26.

Note: Here, the Declarant must state at least one error in the original patent and describe it, e.g., "by reason of a defective specification or drawing" or "by reason of the patentee claiming more or less than he had the right to claim in the patent," particularly specifying the defects and distinctly specifying the excess or insufficiency in the claims. It is no longer required to specify details as to how the error arose or occurred. If any errors are corrected during reissue prosecution that were not specified herein, a Supplemental Reissue Declaration must be filed prior to allowance in compliance with 37 C.F.R. §1.175.

All errors being corrected in this reissue application up to the time of filing of this declaration under 35 CFR §1.175(a) arose without any deceptive intention on the part of the applicant.

#### OFFER TO SURRENDER ORIGINAL PATENT 37 C.F.R. §1.178

Applicant hereby offers to surrender the original patent, the reissue of which is sought herein.

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<sup>2</sup>35 U.S.C. §251 forbids enlarging the scope of the original claims unless the reissue application is filed within two years of the grant of the original patent.

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## POWER OF ATTORNEY

I hereby appoint the following persons as attorney(s) and/or agent(s) to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith:

John W. Caldwell

Registration No. 28, 937

Joseph Lucci

Registration No. 33,307

of **WOODCOCK WASHBURN KURTZ MACKIEWICZ & NORRIS LLP**, One Liberty Place - 46<sup>th</sup> Floor, Philadelphia, Pennsylvania 19103 and

Herb Boswell

Registration No. 27,311

Laurel Bernstein

Registration No. 37,280

Edward D. Robinson

Registration No. 43,049

Robert S. Andrews

Registration No. P44,508

of **ISIS PHARMACEUTICALS, INC.**, 2292 Faraday Avenue, Carlsbad, California 92008

Address all telephone calls and correspondence to:

**Joseph Lucci****WOODCOCK WASHBURN KURTZ MACKIEWICZ & NORRIS LLP**

One Liberty Place - 46th Floor

Philadelphia, PA 19103

Telephone No. 215-568-3100.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

<b>Name:</b> Chris Buhr	
<b>Mailing Address:</b> 870 Campus Drive #303	<b>Signature</b> _____
<b>City/State of Actual Residence:</b> Daly City, CA 94015	<b>Date of Signature:</b> _____
	<b>Citizenship:</b> <u>U.S.A.</u>

<b>Name:</b> Mark Matteucci	
<b>Mailing Address:</b> 1524 Columbus Avenue	<b>Signature</b> _____
<b>City/State of Actual Residence:</b> Burlingame, CA 94010	<b>Date of Signature:</b> _____
	<b>Citizenship:</b> <u>U.S.A.</u>

<b>Name:</b> Norbert W. Bischofberger	
<b>Mailing Address:</b> 1116 Cedar Street	<b>Signature</b> _____
<b>City/State of Actual Residence:</b> San Carlos, CA 94070	<b>Date of Signature:</b> _____
	<b>Citizenship:</b> <u>U.S.A.</u>

<b>Name:</b> Brian Froehler	
<b>Mailing Address:</b> 2310 Monserat Avenue	<b>Signature</b>
<b>City/State of Actual Residence:</b> Belmont, CA 94002	<b>Date of Signature:</b> _____
	<b>Citizenship:</b> <u>U.S.A.</u>

<b>Name:</b>	
<b>Mailing Address:</b>	<b>Signature</b>
<b>City/State of Actual Residence:</b>	<b>Date of Signature:</b> _____
	<b>Citizenship:</b> _____

<b>Name:</b>	
<b>Mailing Address:</b>	<b>Signature</b>
<b>City/State of Actual Residence:</b>	<b>Date of Signature:</b> _____
	<b>Citizenship:</b> _____

Note: Even though inventor(s) do not sign, complete above information for inventor(s).

☒ By assignee or person authorized to sign on behalf of assignee:

Date: 9-29-98

ISIS PHARMACEUTICALS, INC.

By: \_\_\_\_\_

B. Lynne Parshall, Esq.  
Executive Vice President and  
Chief Financial Officer

Check proper box(es) for any added page(s) forming a part of this declaration:

- ☐ Signature for fifth and subsequent joint inventors. Number of pages added \_\_\_\_.
- ☐ Signature by administrator(trix), executor(trix) or legal representative for deceased or incapacitated inventor. Number of pages added \_\_\_\_.
- ☐ Signature for inventor who refuses to sign or cannot be reached by person authorized under 37 C.F.R. § 1.147. Number of pages added \_\_\_\_.
- ☐ Authorization of attorney(s) to accept and follow instructions from representative.

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**ADDED PAGE TO COMBINED DECLARATION AND POWER OF ATTORNEY  
FOR ISSUE APPLICATION FOR AUTHORIZATION OF ATTORNEY(S)  
TO ACCEPT AND FOLLOW INSTRUCTIONS FROM REPRESENTATIVE**

The undersigned to this Combined Declaration and Power of Attorney hereby authorize(s) the U.S. Attorney(s) named herein to accept and follow instructions from:

\_\_\_\_\_  
Name(s) of authorized representative(s)

\_\_\_\_\_  
Address

\_\_\_\_\_  
as to any actions to be taken in the Patent and Trademark Office regarding this application without direct communication between the U.S. attorney(s) and the undersigned. In the event of a change in the person(s) from whom instructions may be taken, the U.S. attorney(s) will be so notified by the undersigned.

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For: NUCLEOSIDE 5'-METHYLENE PHOSPHONATES

Assistant Commissioner for Patents  
Washington DC 20231

Sir:

**CONSENT OF ASSIGNEE FOR REISSUE**  
**and**  
**ASSIGNEE'S STATEMENT OF OWNERSHIP INTEREST IN REISSUE<sup>1</sup>**

I. In accordance with 37 CFR §1.172(a), ISIS Pharmaceuticals, Inc., assignee of the entire interest in U.S. Patent No. 5,672,697, granted on September 30, 1997, to inventor(s) **Chris Buhr, Mark Matteucci, Norbert W. Bischofberger, and Brian Froehler**, hereby consents to reissue of said patent for the reasons set forth in the accompanying Reissue Declaration.

II. In accordance with 37 CFR §1.172(a), said assignee of the entire interest in United States Patent No. 5,672,697, hereby establishes assignee's ownership of said patent and its right to take action therein under 37 CFR §3.73(b) by:

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\* Enter the Group Art Group and Examiner from which the original patent was issued.

<sup>1</sup> This paper must accompany the application for reissue.

09408396-092999

☒ specifying that evidence of said ownership is recorded in the Office for each

assignment in the chain of title at Reel 5666, Frame 0340 and at Reel 9833, Frame 0012.

[Note: list reel and frame for each assignment in chain]

☒ enclosing herewith copies of executed assignment(s) dated February 28, 1991,  
March 20, 1991 and March 18, 1999 which have been submitted for recording in the Office.

[Note: if other documentation is necessary to show ownership, the Office may require recordation thereof under 37 CFR §2.73(b).]

Date: 9/29/99

ISIS PHARMACEUTICALS, INC.

By: \_\_\_\_\_  
B. Lynne Parshall, Esq.  
Executive Vice President and  
Chief Financial Officer

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